

**Brittain, J.****U.S. Serial No. 09/682,699****REMARKS**

Claims 1-30 are pending in the present application. In the Office Action mailed June 30, 2003, the Examiner rejected claims 1-29 under 35 U.S.C. §102(e) as being anticipated by Machida (USP Application No. 2002/0115929 A1). Claims 1-4, 7, 8, 10-12, and 22 were rejected under 35 U.S.C. §102(b) as being anticipated by the Dietrich et al. article "Extending the coverage of true volume scans by continuous movement of the subject". Claims 13-14 and 30 were rejected under 35 U.S.C. §103(a) as being anticipated by the Dietrich et al. article. Applicant appreciates the Examiner's consideration of remarks presented April 18, 2003.

**Declaration Deficiencies**

Accompanying the Response of April 18, 2003, Applicant provided a declaration stating that "from before September 21, 2001 to October 5, 2001, the filing date of the above-referenced Patent Application," Applicant had conceived of and work diligently toward a constructive reduction to practice of the claimed invention. Applicant included with the statement an Exhibit A as evidence of conception. However, the Examiner now rejects the declaration as failing to establish reduction to practice prior to, (i.e. at least one day earlier than) the effective date of the reference, because 37 CFR 1.131(b) states that in order to antedate a reference, Applicant must be able "to establish reduction to practice prior to the effective date." (emphasis added).

The Examiner has found Applicant's declaration deficient because Applicant used the word "before" rather than "prior to." Applicant does not believe that language of 37 CFR 1.131(b) is to be interpreted in such a narrow manner that would dictate that there is a distinction between the meaning of "before" as opposed to the meaning of "prior to." Nevertheless, Applicant has enclosed a definition of the word "before" as defined by wordsmyth.net. Applicant has highlighted that wordsmyth.com specifically states that a cross-reference synonym of "before" is "prior to." Accordingly, Applicant believes the declaration to be fully within the breadth of 37 CFR 1.131(b).

The Examiner further objected to Exhibit A, which Applicant provided in support of the declaration, and stated that "[o]riginal exhibits of drawings or records, or photocopies thereof, must accompany...the affidavit or declaration" as set forth in 37 CFR 1.131(b). The Examiner's position is that Applicant has not complied with the CFR because Applicant redacted portions of

**Brittain, J.****U.S. Serial No. 09/682,699**

Exhibit A and the cited section states that the *original* or photocopies of the *original* must be supplied. The Examiner stated that as a result of the redacting, Exhibit A failed to establish an *actual date* prior to the effective date of Machida. Applicant adamantly asserts that (1) Applicant has provided a photocopy of the original, (2) Applicant has the right to redact portions of the photocopy (3) the redaction does not negate that Exhibit A is a photocopy of the original, and (4) the Applicant is under no duty to provide an *actual date* of conception.

Specifically, MPEP §715.07 clearly states that “[w]hen alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date.” Additionally, as stated, 37 CFR 1.131(b) explicitly permits submission of photocopies. Therefore, when 37 CFR 1.131(b) is interpreted in light of MPEP §715.07, (1) Applicant has provided a photocopy of the original, (2) Applicant has the right to redact information irrelevant to the establishment of conception, reduction to practice, and due diligence, including dates, and (3) the redaction does not negate Exhibit A’s satisfaction of 37 CFR 1.131(b). MPEP §715.07 also states that “the actual dates of acts relied on to establish diligence must be provided.” Applicant clearly established such by stating “[t]hat from before September 21, 2001 to October 5, 2001, the filing date of the above-referenced Patent Application, [Applicant] diligently worked toward reducing the aforementioned invention to practice and worked with patent counsel in the preparation of a patent application for the claimed invention.” (emphasis added). Applicant believes this statement when accompanied with Exhibit A clearly provides the requisite information necessary to evidence conception and diligence toward constructive reduction to practice *prior to* the effective date of Machida.

### **Rejections Under §112**

The Examiner rejected claim 30 because there is insufficient antecedent basis for the limitation of “selecting a larger slab thickness than that used for imaging.” However, Applicant is unclear as to what exactly the Examiner is attempting to convey when explaining the rejection. First, the Examiner states that “at least one method step which provides proper antecedent basis is missing from claim 30” because the limitation of “selecting a larger slab thickness than that

**Brittain, J.****U.S. Serial No. 09/682,699**

used for imaging” and “repetitiously acquiring MR data for the larger slab thickness” lacks antecedent basis. However, the very claim elements cited by the Examiner are clear that a larger slab thickness than required for imaging is selected and that MR data is repetitiously acquired for the larger slab thickness. Therefore, antecedent basis is clearly provided.

Second, the Examiner states that “if applicant resolves the antecedent basis problem applicant by amendment there will still be an issue of which slab thickness the applicant uses to determine the ‘overlapping data set’ because the relevancy of the Prior art, and the last feature of claim 30 is dependent upon a proper clarification of which slab thickness is overlapped.” Applicant is again unclear as to the meaning of this statement. Specifically, Applicant does not know what the Examiner means by “the relevancy of the Prior art” and “the last feature of claim 30 is dependent upon proper clarification of which slab thickness is overlapped.” Claim 30 does not call for slab thickness to be overlapped but clearly calls for “a data set of overlapping MR data.” Applicant believes the Examiner is reading limitations into the claims that are not present. This is improper. Applicant believes that if claim 30 is interpreted based upon the claim elements that are *actually* called for, claim 30 is proper. Should the Examiner wish to perpetuate this line of examination, Applicant requests that the Examiner rearticulate the rejection and the basis for the rejection in short concise statements so that the Examiner’s interpretation is clear.

### **Rejections Under §102**

Regarding the rejection of claims 1-29 as anticipated by Machida, Applicant refers the Examiner to the previous section discussing the Declaration and Exhibit which antedate the reference. As such, Applicant believes Machida is not a proper reference under §102(e).

Regarding the rejection of claims 1 as anticipated by Dietrich et al. the Examiner asserts that “Dietrich et al., also teaches and suggests... ‘repeatedly exciting and encoding spins with readout in the first direction’ (i.e. the z direction) [See concept paragraph 1 in col. 1].” Dietrich et al. makes no such teaching. Furthermore, the section cited by the Examiner teaches directly away from that which the Examiner asserts.

Claim 1 explicitly calls for “readout in the first direction,” which is also the direction of motion (i.e. typically designated the z direction). On the other hand, Dietrich et al., in the very section cited by the Examiner, states “frequency encoding [is] along the X and primary phase

**Brittain, J.****U.S. Serial No. 09/682,699**

encoding [is] along Y augmented by secondary phase encoding in the slab (slice) direction." Col. 1, ¶ 2. "During the scan the subject is progressively moved in the Z direction." *Id.* Therefore, the direction of motion in Dietrich et al. is in the Z direction while primary phase encoding is in the Y direction and, most importantly, frequency encoding is in the X direction. As one of ordinary skill in the art will readily recognize and as stated by Applicant's Specification, the direction of readout is synonymous with the direction of frequency encoding. *See Detailed Description*, p. 20. Therefore, claim 1 calls for readout in the direction of motion (i.e. the Z direction) while Dietrich et al. explicitly teaches the readout is in a direction other than that of motion because it teaches frequency encoding in the X direction and the direction of frequency encoding is the direction of readout. Accordingly, Dietrich et al. teaches away from that which is claimed. As such, claim 1 is patentably distinct from the art of record. Further more, claims 2-4, 7, 8, and 10-12 are in condition for allowance pursuant to the chain of dependency.

Regarding the rejection of claims 2-4, 7, 8, and 10-12 under §102(b) as being anticipated by the Dietrich et al., because the claims depend from an otherwise allowable claim, Applicant believes each of these claims is in condition for allowance pursuant to the chain of dependency.

Regarding the rejection of claim 22, Applicant has amended the claim to explicitly clarify that the frequency encoding is performed in the first direction and that the first direction is the direction of continuous movement. As previously stated with respect to claim 1, Dietrich et al. is clear that "frequency encoding [is] along X." Col. 1, ¶ 2. In contrast, the claimed invention, as defined by claim 22, is directed to a "moving table with frequency encoding in the Z-direction." Dietrich et al. explicitly teaches frequency encoding in the X-direction and as such, claim 22 is patentably distinct from the art of record.

### **Rejections Under §103**

Regarding the Examiner's rejection of claims 13-14 and 30 under 35 U.S.C. §103(a), Applicant respectfully disagrees with the Examiner with respect to the art as applied. However, in light of each of the aforementioned claims depending from what is believed an otherwise allowable claim, Applicant does not believe additional remarks are necessary and therefore requests allowance of claims 13-14 and 30 pursuant to the chain of dependency.

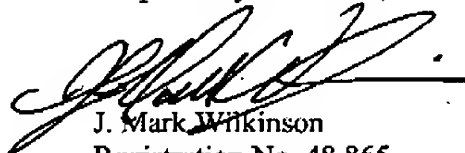
**Brittain, J.**

**U.S. Serial No. 09/682,699**

Therefore, in light of the foregoing, Applicant respectfully believes that the present application is in condition for allowance. Accordingly, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-30.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



J. Mark Wilkinson

Registration No. 48,865

Direct Dial 262-376-5016

[jmw@zpspatents.com](mailto:jmw@zpspatents.com)

Dated: August 20, 2003  
Attorney Docket No.: GEMS8081.060

**P.O. ADDRESS:**

Ziolkowski Patent Solutions Group, LLC  
14135 North Cedarburg Road  
Mcquon, WI 53097-1416  
262-376-5170

**FAX RECEIVED**

**AUG 21 2003**

**GROUP 2800**

**OFFICIAL**